

**REMARKS/ARGUMENTS**

Claims 45-50 are previously presented. Claims 51-53 are amended for clarity. Claims 1-44 have been cancelled by a previous Amendment. Applicants respectfully reserve the right to pursue the subject matter of any cancelled claims in any forthcoming continuation application(s). Reconsideration of the above claims is respectfully requested in light of the arguments herein.

**I. Examiner Interview Dated January 8, 2009**

An interview was held on January 8, 2009. An agreement as to allowability was not reached. Applicants believe that an agreement was reached that Examiner Shapiro would need to reconsider the claims in light of the interview. In particular, during the interview applicants' attorney noted that none of the figures of the reference indicate in combination with a computer-displayed handwritten text selection, determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection and setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection. Throughout the references, the references indicate that the entirety of the text is selected including portions above and below the text. As indicated in the interview, the height configuration as indicated in the claims is important to the disclosure because computer-displayed handwritten text can have great discrepancies between that ascending and descending portions of letters. If the ascending and descending portions were considered, the highlighting could become intrusive by taking up a large portion of the display relative to the ascending and descending character segments. Such an intrusive highlight would be overly inclusive of the portion of the highlight that conveys that the section is highlighted.

## **II. Discrepancies in the Office Action**

The Office Action fails to address the changes made in the Amendment After Final Rejection that was filed with the RCE dated November 3, 2008. In the Amendment entered with the RCE, the claims were amended to recite “in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically....” In that this feature was not considered in the current Office Action, applicants assert that the next Office Action in this matter cannot be final.

## **III. Rejections Under 35 U.S.C. § 103(a)**

Claims 45-53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2004/0021701 published to Iwema et al. (hereinafter “Iwema”) in view of U.S. Patent No. 5,757,383 issued to Lipton (hereinafter “Lipton”). Applicants respectfully disagree with the rejection. Independent claim 45 includes the following combination of features that is not taught or otherwise suggested by the cited references:

selecting an electronic pen for functioning as an electronic highlighter device;

engaging the electronic pen with a computer-displayed handwritten text selection;

in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection, wherein determining the height of the computer-displayed handwritten text selection includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection; and

setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection.

The above combination of features is not taught or otherwise suggested by the cited references. With regard to Iwema, Iwema teaches a selection tool that includes graphical handles that may be used to indicate the vertical bounds of the selection ink path and the starting point and end point of the selection ink path. The graphical handles are indicated in Fig. 5 by reference numeral 410. (Iwema at ¶ 0055). In paragraph 0037 of Iwema, Iwema teaches a freeform selection line. (Iwema at ¶ 0037). The encounter selection tool selects graphical objects that are touched by the selection line. As indicated in Fig. 5, as the user uses the selection tool, the ink text that engages the selection is graphically changed. As indicated in paragraphs 0037 and 0055 of Iwema, Iwema teaches that the selection ink path is dictated by what the user sets as the vertical bounds for the graphical handles. Iwema does not teach “in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection, wherein determining the height of the computer-displayed handwritten text selection includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection,” in combination with “setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection.” Stated another way, Iwema does not teach the automatic determination response to the engagement of the electronic pen with the computer-displayed handwritten text selection. Furthermore, Iwema does not teach the determination of the height of the ink as indicated in independent claim 45.

Lipton does not remedy the lack of teaching in Iwema. In Lipton, Lipton chooses a portion of text to highlight by inserting a base-line. As indicated, the base-line is associated with the orientation of the text input. A dashed shape is then input having a top and bottom line. The top line is offset from the base-line of the geometric path. The bottom line is also offset from the geometric path. The upper and lower lines are then connected to form a geometric shape.

(Lipton at Col. 3, lines 50-65). The shape is formed by requesting a graphic system to return the distance that the top line segment is positioned above the base-line. The bottom line is positioned below the base-line which is called the descent. It is also positioned by requesting the graphic system to return such a distance. The ascent and the descent are determined by calling a function called “GXGetLayoutSpan”. (Lipton at Col. 4, lines 37-47). In further regard to Lipton, Lipton teaches that the present invention is intended to apply to other forms of selection. The example given in Lipton includes a selection method that blocks half the height of the typography rather than the entire height. Lipton continues with the example by indicating that it should also be understood that the continuous highlighting method and system of the present invention will work for typography formed from languages other than English. (Lipton at Col. 5, lines 27-37). All of the figures within Lipton indicate a highlighting of the words in their entirety. (See Fig. 8). Lipton does not teach or otherwise suggest “in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection, wherein determining the height of the computer-displayed handwritten text selection includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection,” in combination with “setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection.” Again, Lipton is teaching the height of the highlight based off of the base-line offset. Furthermore, Lipton depicts that the height of the ink spans the entirety of the text. The fact that Lipton teaches a selection method that blocks half the height of the type rather than the entire height is not the same as teaching an average height of the computer-displayed handwritten text without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection. Accordingly, applicants assert that independent claim 45 is allowable over the cited references. Reconsideration is respectfully requested.

Independent claim 48 includes the following combination of features that is not taught or otherwise suggested by the cited references:

selecting an electronic pen for functioning as an electronic highlighter device;

engaging the electronic pen with a computer-displayed handwritten text selection;

in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection, wherein determining the height of the computer-displayed handwritten text selection includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection;  
and

setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection.

The above combination of features is not taught or otherwise suggested by the cited references. With regard to Iwema, Iwema teaches a selection tool that includes graphical handles that may be used to indicate the vertical bounds of the selection ink path and the starting point and end point of the selection ink path. The graphical handles are indicated in Fig. 5 by reference numeral 410. (Iwema at ¶ 0055). In paragraph 0037 of Iwema, Iwema teaches a freeform selection line. (Iwema at ¶ 0037). The encounter selection tool selects graphical objects that are touched by the selection line. As indicated in Fig. 5, as the user uses the selection tool, the ink text that engages the selection is graphically changed. As indicated in paragraphs 0037 and 0055 of Iwema, Iwema teaches that the selection ink path is dictated by what the user sets as the vertical bounds for the graphical handles. Iwema does not teach “in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection, wherein determining the height of the computer-displayed handwritten text selection includes

determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection,” in combination with “setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection.” Stated another way, Iwema does not teach the automatic determination response to the engagement of the electronic pen with the computer-displayed handwritten text selection. Furthermore, Iwema does not teach the determination of the height of the ink as indicated in independent claim 48.

Lipton does not remedy the lack of teaching in Iwema. In Lipton, Lipton chooses a portion of text to highlight by inserting a base-line. As indicated, the base-line is associated with the orientation of the text input. A dashed shape is then input having a top and bottom line. The top line is offset from the base-line of the geometric path. The bottom line is also offset from the geometric path. The upper and lower lines are then connected to form a geometric shape. (Lipton at Col. 3, lines 50-65). The shape is formed by requesting a graphic system to return the distance that the top line segment is positioned above the base-line. The bottom line is positioned below the base-line which is called the descent. It is also positioned by requesting the graphic system to return such a distance. The ascent and the descent are determined by calling a function called “GXGetLayoutSpan”. (Lipton at Col. 4, lines 37-47). In further regard to Lipton, Lipton teaches that the present invention is intended to apply to other forms of selection. The example given in Lipton includes a selection method that blocks half the height of the typography rather than the entire height. Lipton continues with the example by indicating that it should also be understood that the continuous highlighting method and system of the present invention will work for typography formed from languages other than English. (Lipton at Col. 5, lines 27-37). All of the figures within Lipton indicate a highlighting of the words in their entirety. (See Fig. 8). Lipton does not teach or otherwise suggest “in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining

the height of the computer-displayed handwritten text selection, wherein determining the height of the computer-displayed handwritten text selection includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection," in combination with "setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection." Again, Lipton is teaching the height of the ink based off of the base-line offset. Furthermore, Lipton depicts that the height of the highlight spans the entirety of the text. The fact that Lipton teaches a selection method that blocks half the height of the type rather than the entire height is not the same as teaching an average height of the computer-displayed handwritten text without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection. Accordingly, applicants assert that independent claim 48 is allowable over the cited references. Reconsideration is respectfully requested.

Independent claim 51 includes the following combination of features that is not taught or otherwise suggested by the cited references:

a processor; and

a memory having computer-executable instructions stored thereon, wherein the computer-executable instruction are configured for:

selecting an electronic pen for functioning as an electronic highlighter device;

engaging the electronic pen with a computer-displayed handwritten text selection;

*in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection, wherein determining the height of the computer-displayed handwritten text selection includes*

determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection; and

setting a height of a cursor for inputting electronic highlighter ink to the determined height, wherein the height of the cursor is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection.

With regard to independent claim 51, applicants assert that the cited references do not teach or otherwise suggest the above combination of features. In support for this contention, applicants rely on the arguments set forth above with regard to the other independent claims. Furthermore, independent claim 51 has been amended to clarify “setting a height of the cursor for inputting electronic highlighter ink to the determined height, wherein the height of the cursor is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection.” Applicants can find no teaching or suggestion within either of the references of such a setting of the height of the cursor as indicated in independent claim 51. Accordingly, applicants assert that independent claim 51 is allowable over the cited references. Reconsideration is respectfully requested.

With regard to the dependent claims, the dependent claims include features that are not taught or otherwise suggested by the cited references. Furthermore, those claims ultimately depend from the independent claims set forth above. As such, they should be found allowable for at least those same reasons.

#### **IV. Request for Reconsideration**

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application,

the Examiner is requested to contact the undersigned attorney for the applicants at the telephone number provided below.

Respectfully submitted,

MERCHANT & GOULD P.C.

  
\_\_\_\_\_  
RYAN T. GRACE  
Registration No. 52,956  
Direct Dial: 402.344.3000

MERCHANT & GOULD P.C.  
P. O. Box 2903  
Minneapolis, Minnesota 55402-0903  
612.332.5300

**27488**

PATENT TRADEMARK OFFICE